Supreme Court, U.S.
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IN THE

Supreme Court of the United States

COLLECTIBLES, INC., d/b/a Collectables Records

Petitioner,

vs.

LEONARD BROWN; WALTER PRICE; PETE MAYES; JAMES NELSON; JOE HUGHES, a/k/a Joe "Guitar" Hughes; RAYFIELD JACKSON, a/k/a "Houston Guitar Slim"; FREDDIE COLLINS, a/k/a "Big Roger" Collins; FALIETA GREEN as Independent Executrix of the Estate of Clarence Green; THOMAS DARDAR, a/k/a Tommy Dardar; ROBBYE R. WALDRON for the Estate of Alfred R. Bettis a/k/a "Big Al" Bettis; DEBRA L. NICKERSON as heir to the Estate of Weldon Bonner a/k/a "Juke Box Bonner"; LIZETTE COBB as heir to the Estate of Arnett Cobb; and KINNEY ABAIR

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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June 21, 2000

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QUESTION PRESENTED

Does the Copyright Act preempt a state law claim for misappropriation of name and likeness brought by an author of a tangible work within the subject matter of copyright for the use of the author's name and likeness in the reproduction and distribution of that work?

LIST OF PARTIES

The parties to the proceedings below are as follows:

1. Petitioner Collectibles, Inc., doing business as Collectables Records, a defendant in the trial court.

2. Respondent Leonard Brown, a plaintiff in the trial court.

3. Respondent Walter Price, a plaintiff in the trial court.

4. Respondent Pete Mayes, a plaintiff in the trial court.

5. Respondent James Nelson, a plaintiff in the trial court.

6. Respondent Joe Hughes also known as Joe "Guitar" Hughes, a plaintiff in the trial court.

7. Respondent Rayfield Jackson also known as "Houston Guitar Slim," a plaintiff in the case in the trial court.

8. Respondent Freddie Collins, also known as "Big Roger" Collins, a plaintiff in the trial court.

9. Respondent Falieta Green, as Independent Executrix of the Estate of the Estate of Clarence Green, a plaintiff in the trial court.

10. Respondent Thomas Dardar, also known as Tommy Dardar, a plaintiff in the trial court.

11. Respondent Robbye R. Waldron, for the Estate of Alfred R. Bettis, also known as "Big Al Bettis," a plaintiff in the trial court.

12. Respondent Debra L. Nickerson, as heir to the Estate of Weldon Bonner, also known as "Juke Boy Bonner," a plaintiff in the trial court.

13. Respondent Lizette Cobb, as heir to the Estate of Arnett Cobb, a plaintiff in the trial court.

14. Respondent Kinney Abair, a plaintiff in the trial court.

15. Lee J. Frazier, also known as "Skipper Lee Frazier," a plaintiff in the trial court against whom the trial court entered a take nothing judgment in favor of Collectibles.

17. Clarence Parker, a plaintiff in the trial court, against whom the trial court entered a take nothing judgment in favor of Collectibles.

18. Jerry Greene, one of the owners of Collectibles and a defendant in the trial court, in whose favor a take nothing judgment was granted.

19. Nina Greene, one of the owners of Collectibles and a defendant in the trial court, in whose favor a take nothing judgment was granted.

20. Roy C. Ames, doing business as Clarity Music and doing business as Home Cooking Records, a defendant in the trial court.

CORPORATE DISCLOSURE STATEMENT

There is no parent or publicly held company owning ten percent or more of the stock of Petitioner Collectibles, Inc.

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OPINIONS BELOW

The judgment and opinion of the United States Court of Appeals for the Fifth Circuit, dated February 7, 2000 and styled *Brown v. Ames*, is reported at 201 F.3d 654 and is reprinted in the Appendix at A1.

The judgment of the trial court, the United States District Court for the Southern District of Texas, dated August 3, 1998, is reprinted in the Appendix at A2.

The order of the United States Court of Appeals for the Fifth Circuit, dated March 23, 2000, denying Petitioner's Petition for Rehearing is reprinted in the Appendix at A3.

JURISDICTIONAL GROUNDS

On February 7, 2000, the United States Court of Appeals for the Fifth Circuit issued its judgment and opinion affirming an award of damages in favor of Respondents and against Petitioner Collectibles for copyright infringement and misappropriation of Respondents' names and likenesses. On March 23, 2000, the Court of Appeals entered an Order denying Collectibles' Petition for Rehearing. This Petition for Writ of Certiorari is being docketed within ninety days from the entry of such Order of the Court of Appeals.

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1), which allows the Court to review by a writ of certiorari a case in the circuit court of appeals after rendition of judgment.

CONSTITUTIONAL PROVISIONS INVOLVED

U.S. Const. art. I, § 8, cl. 8: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by

securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

U.S. Const. art. VI, cl. 2:

> This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.

STATUTE INVOLVED

17 U.S.C. § 301(a):

> On or after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

STATEMENT OF THE CASE

This Petition is brought as result of the Court of Appeals for the Fifth Circuit affirming a judgment against Petitioner

Collectibles in favor of thirteen blues musicians, or their heirs who, invoking the subject matter jurisdiction of the district court under the Copyright Act, claimed that Collectibles had infringed their copyrights in their musical works by the reproduction and distribution of compact discs ("CD's") and cassette tapes that included those works. The musicians also brought pendent state law claims alleging that Collectibles misappropriated the musicians' names and likenesses in the sale and distribution of such CD's and cassette tapes containing the musicians' tangible work. The Court of Appeals found that such claims were not preempted by the Copyright Act and let stand an award of damages against Collectibles for misappropriation of name and likeness that was fifteen times greater than what the musicians were awarded under the Copyright Act.

Collectibles is a record label that distributes and sells musical recordings, and in particular repackaged vintage recordings commonly known as "oldies." Beginning in or about 1990, Roy C. Ames, a music producer in Houston, Texas, entered into a series of agreements with Collectibles by which Ames licensed certain master recordings, including those embodying performances of the Respondent musicians, to Collectibles for commercial exploitation. The license agreements granted Collectibles the right to use the names, photographs, likenesses and biographical material of all persons whose performances were embodied on the licensed master recordings. As a result of these license agreements from Ames, Collectibles manufactured and distributed CDs and cassette tapes containing the musical recordings of the musicians. Those CDs and cassettes included the names and, in some cases, the likenesses of one or more of the Respondent musicians.

In 1994, fifteen musicians, including the thirteen Respondents herein, sued Ames, Collectibles and two individual owners of Collectibles, Jerry and Nina Greene, claiming that,

despite the fact that the musicians had either recorded songs for Ames or had delivered master recordings to Ames, Ames had no right to license the recordings for commercial exploitation. The musicians, or their heirs, alleged copyright infringement, negligence, conversion, misappropriation of name and likeness and violations of the Lanham Act with regard to 146 songs that were reproduced and distributed by Collectibles.

Regardless of the label placed on their causes of action, the gravamen of the musicians' complaint against Collectibles was that Ames was not authorized to exploit the musicians' master recordings and therefore Ames' license to Collectibles was invalid, meaning that Collectibles was not authorized to reproduce and distribute the musicians' songs.[1] Collectibles filed an answer asserting that the musicians' state law claims for negligence, conversion and misappropriation of name and likeness were preempted by the Copyright Act.

Prior to trial, and upon motion of Collectibles, the District Court dismissed the musicians' negligence and conversion claims as preempted by the Copyright Act. The District Court also dismissed the copyright claims of those musicians who had not timely obtained copyright registration certificates. The District Court denied Collectibles' motion for judgment as a matter of law that the musicians' misappropriation claims were preempted. Consequently, the musicians' actions for copyright infringement, violations of the Lanham Act, and misappropriation of name and likeness proceeded to jury trial. In support of their damages claim, the musicians presented expert testimony regarding the royalties that would be due and owing to each of the musicians based on a mechanical license royalty rate for the

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[1]In addition to claiming a copyright in the sound recordings, some of the musicians asserted a musical composition copyright for recorded songs they claim to have also written.

number of CDs and cassettes sold or distributed by Collectibles.

At the close of the musicians' case, the trial court granted judgment as a matter of law in favor of Jerry and Nina Greene. The jury returned a verdict in favor of Collectibles on the musicians' Lanham Act claims, finding that Collectibles had not made false statements of fact that deceived or potentially deceived customers. The jury found that Collectibles had infringed, innocently, the copyrights of three of the musicians, Pete Mayes, James Nelson and Leonard Brown, and had misappropriated the names and likenesses of thirteen of the musicians, including Mayes, Nelson and Brown, in the sale and distribution of CDs and cassettes. The jury awarded a total of $27,000.00 in damages against Collectibles for misappropriation of name and likeness.

Because of the paucity of sales of the musicians' recordings, the musicians elected statutory damages under the Copyright Act. The trial court awarded $200.00 in damages against Collectibles for each of the nine works found to have been innocently infringed, for total damages for copyright infringement of $1,800.00. Based on the jury's verdict, the court entered judgment in favor of the thirteen Respondents and against Collectibles in the total amount of $27,000.00 for misappropriation of their names and likenesses.[2]

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[2]The Court awarded $22,500 in damages for copyright violation against Ames, whose infringement was found not to be innocent, and $100,000 in damages against Ames for misappropriation of name and likeness based on the jury verdict. Ames, although an appellant in the Court of Appeals, is not a party to this Petition for Writ of Certiorari.

HOW THE FEDERAL QUESTION WAS RAISED

The musicians invoked the subject matter jurisdiction of the district court under the Copyright Act, 17 U.S.C. § 101 et seq., and under the Lanham Act, 15 U.S.C. § 1051 et seq., and brought their pendent state law claims under 28 U.S.C. § 1338(a). In Collectibles' Answer, Collectibles asserted that the musicians' state law claims, including the musicians' claims for misappropriation of name and likeness, were preempted by the Copyright Act, 17 U.S.C. § 301(a). Collectibles filed a motion for judgment as a matter of law on the preemption issue prior to trial, at the close of the musicians' evidence, prior to the submission of the misappropriation claim to the jury, and after the jury verdict. The district court denied Collectibles' motions.

REASONS FOR GRANTING THE WRIT

The specific question presented by this Petition -- whether a state law claim for misappropriation of name and likeness is preempted by the Copyright Act when the right protected by state law is claimed in a tangible work within the subject matter of copyright -- has not been addressed by this Court, and the Circuit Courts of Appeals are in conflict. The Fifth Circuit has decided a matter of law that is vital to the continued vitality of the uniform federal system promulgated by the Copyright Act for protecting and enforcing rights in original works of authorship fixed in a tangible medium of expression. However, in failing to find that preemption exists when a recording artist brings a state law cause of action for misappropriation of his name and likeness in connection with the reproduction and distribution of the artists' own musical works, the Fifth Circuit has seriously undermined the Copyright Act's strong preemption provision and has thwarted the aims of Congress. Indeed, the Fifth Circuit has decided this issue in a way that would allow virtually every claim for the unauthorized copying and distribution of a musical work,

or any work fixed in a tangible medium of expression for that matter as long as it includes the name or likeness of the artist on it, to be recast as a misappropriation of name or likeness claim and brought in state court. This case presents an opportunity for this Court to decide the extent to which the increasingly prevalent claims under state common law for misappropriation of name and likeness, and for violation of a right of publicity, can exist without threatening the uniform system of rights and remedies envisioned by Congress for works fixed in a tangible medium of expression and codified in 17 U.S.C. § 301(a).

In the absence of guidance from this Court, the Circuit Courts of Appeals have addressed the issue of preemption by the Copyright Act of state law claims for misappropriation of name and likeness in conflicting and inconsistent ways when the author's name or likeness appears in a tangible work within the subject matter of copyright. The Fifth Circuit's opinion adopts the analysis of the Ninth Circuit in several cases that are not analogous to the case at bar, but in so doing presents a direct conflict with authority from the Seventh and Eleventh Circuits. The resolution of such a conflict is critical to the promotion of a uniform federal system of rights and remedies for works fixed in a tangible medium of expression.

A THE FIFTH CIRCUIT HAS DECIDED AN IMPORTANT QUESTION OF FEDERAL LAW, THAT HAS NOT BEEN SETTLED BY THIS COURT, IN A WAY THAT UNDERMINES THE SINGLE FEDERAL SYSTEM OF RIGHTS AND REMEDIES FOR WORKS FIXED IN A TANGIBLE MEDIUM OF EXPRESSION ENVISIONED BY CONGRESS

Section 301(a) of the Copyright Act expresses the clear federal policy of a uniform method for protecting and enforcing rights in copyrightable works by preempting other claims.

Indeed, the preemption provision of the Copyright Act, when enacted in 1978, was "one of the bedrock provisions of the Bill," as it existed in the House. H.R. Rep. No. 1476, 94th Cong. 2d Sess.201 (1976), *reprinted following* 17 U.S.C.A. § 301, at 375. The House Committee on the Judiciary commented:

> By substituting a single Federal system for the present anachronistic, uncertain, impractical, and highly complicated dual system, the bill would greatly improve the operation of the copyright law and would be much more effective in carrying out the basic constitutional aims of uniformity and promotion of writing and scholarship.
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> . . .
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> One of the fundamental purposes behind the copyright clause of the Constitution, as shown in Madison's comments in The Federalist, was to promote national uniformity and to avoid the practical difficulties of determining and enforcing an author's rights under the differing laws and in the separate courts of the various States. Today, when the methods for dissemination of an author's work are incomparably broader and faster than they were in 1789, national uniformity in copyright protection is even more essential than it was then to carry out the constitutional intent.

Id. The House Committee also stated:

> The intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of the Federal copyright law. The declaration of

> this principal in section 301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection.

Id. at 376. Despite this strong and clear pronouncement of the preemptive intent of the Copyright Act, and in the absence of authority on the issue from this Court, there now exist "vague borderline areas" between state and federal law when a plaintiff brings a cause of action for misappropriation of name and likeness in connection with a copyrightable work. Collectibles therefore urges review of this issue by this Court.

(i) The State Law Rights Being Asserted

The musicians in this case asserted claims for misappropriation of name and likeness under Texas state common law. The musicians contended that Collectibles improperly used their names, and in some cases their images, in connection with Collectibles' reproduction and distribution of CDs and cassette tapes containing their musical works. Texas has recognized a cause of action for misappropriation of name and likeness as a subspecies of invasion of privacy tort. *Kimbrough v. Coca Cola/U.S.A.*, 521 S.W.2d 719, 722 (Tex. Civ. App. -- Eastland 1975, writ ref'd n.r.e.); *Moore v. Big Picture Co.*, 828 F.2d 270, 275 (5th Cir. 1987); *Matthews v. Wozencraft*, 15 F.3d 432, 437 (5th Cir. 1994); *see also* W. PAGE KEETON, ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 851-52 (5th ed. 1984); Restatement (Second) of Torts, § 652(C) (1977).

To prove misappropriation, a plaintiff generally has to show that his or her personal identity, sometimes referred to as his or her "persona," has been appropriated by the defendant for some commercial advantage. *Moore*, 828 F.2d at 275. The classic type of misappropriation claim involves a prominent person's name or likeness being used to show or imply an endorsement of a product or service of the defendant in the advertising for that product or service, when in fact the person does not endorse that product or service. *See* Restatement (Second) of Torts § 652(C), cmt. b (1977).

In this case, the Fifth Circuit viewed a cause of action for misappropriation of name and likeness as synonymous with a cause of action for violation of a right of publicity.[3] Indeed, the court's opinion at one point references "the right of publicity that the misappropriation tort protects." *Brown v. Ames*, 201 F.3d 654, 660 (5th Cir. 2000). Commentators and courts alike have discussed the similarities and differences between a claim for misappropriation of name and likeness and a claim for the violation of a right of publicity as such causes of action exist from state to state. *See, e.g., Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1446-47 (11th Cir. 1998) (citing J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:6 (1997)). Since under Texas law a plaintiff has a cause of action for damages to his commercial interests by virtue of misappropriation of his name or likeness, rather than for damages to his feelings or reputation, the right protected by Texas

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[3]Texas has codified a right of publicity with regard to deceased persons in Tex. Prop. Code § 26.001 et seq. (Vernon's 2000). Respondents in the court below, however, did not bring a cause of action under the Texas right of publicity statute, but rather under Texas common law. *See Kimbrough*, 521 S.W.2d at 721-22.

common law may be viewed as a right of publicity.[4] Consequently, the arguments in this Petition apply whether the state law claim subject to preemption is couched as a claim for misappropriation of name and likeness or a claim for violation of a right of publicity.[5]

(ii) The Question Presented Has Not Been Settled Or Addressed By This Court

In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), this Court recognized a right of publicity under state law and held that such a claim was not necessarily preempted by the First Amendment. However, *Zacchini* offers little guidance with regard to the preemption of a right of publicity under the Copyright Act. Indeed, the *Zacchini* case is not factually analogous to the situation being presented to this Court. In *Zacchini*, which was decided prior to the Copyright Act of 1978, the plaintiff performed a "human cannonball" act and had chosen not to fix his work in a tangible medium of expression. In the case at bar, the musicians not only consented to their works being fixed in a tangible medium of expression but indeed placed their works in a tangible medium of expression themselves and then

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[4]Indeed, it would be incongruous for musicians who have attempted to publicly identify themselves with their works by filing for copyright registration to claim damages to their feelings or reputations as a result of an invasion of privacy for being identified with such works.

[5]As of 1998, 25 states have recognized a right of publicity by either statute or common law, though nine of those states may not have termed it as such. *See Allison v. Vintage Sports Plaques*, 136 F.3d at 1446 citing J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY, § 6.1(B) (1997); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996). The term "right of publicity" has its origins in the Second Circuit's opinion in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

claimed a copyright in the tangible work.[6] Moreover, contrary to Hugo Zacchini, the musicians in this case could protect themselves quite adequately against the reproduction and distribution of their recordings by availing themselves of the rights and protections of the Copyright Act. Thus, while extrapolations from *Zacchini* are possible, *see, e.g.,* Marc J. Apfelbaum, Note: *Copyright and the Right of Publicity: One Pea in Two Pods?* 71 Geo. L.J. 1567 (1983), they do not assist in resolving the conflict between copyright law and state law rights of publicity. *See* David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 Cornell L. Rev. 673, 700-01 (1981).[7]

This Court's holdings in *Goldstein v. California*, 412 U.S. 546 (1973), *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974), and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), also do not address the specific issue presented in this Petition. *Goldstein* was decided prior to the amendments to the Copyright Act in 1978 by which Congress expressed its intent to completely preempt any state regulation of works fixed

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[6]The fact that *Zacchini* involved a plaintiff's rights in a non-copyrighted "performance" rather than a tangible work was noted by the court in *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 650 n.5 (Cal. App. 1996).

[7]*Zacchini* involved an analysis of the right of publicity as it affects freedom of expression under the First Amendment. This Court held that such a claim was not necessarily preempted by the First Amendment. Since that time, other circuits have found that claims for violations of rights of publicity could be preempted on the basis of the First Amendment. *Cardtoons*, 95 F.3d at 976; *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). While the issue of First Amendment protection does overlap with this area of law, and an analogy could be drawn to these cases especially since the jury determined that Collectibles had not made any false statement of fact regarding the sound recordings or the artist's affiliation with the sound recordings, Collectibles presents this Petition to urge the Court to decide the issue of the scope of preemption under the Copyright Act.

in a tangible medium of expression. In *Goldstein*, because the 1909 Copyright Act excluded sound recordings from its scope, this Court upheld the constitutionality of a state record piracy statute and indicated an intent to allow state regulation of "writings" that did not fall within the scope of the Federal Copyright Act of 1909. There can no question that since that time Congress has established a pervasive copyright scheme for the protection of rights that are subject to the Act, and specifically rights associated with musical works, including sound recordings.

Kewanee Oil Co. and *Bonito Boats, Inc.* each involved preemption under the federal patent laws. In *Kewanee*, this Court held that the federal patent laws did not preempt causes of action under state trade secret laws. 416 U.S. at 491-92. In *Bonito Boats, Inc.* the Court found that a state law claim under a statute that provided patent-like protection for ideas that do not qualify for federal patent law protection was preempted. While these cases apply the general test for preemption in an intellectual property context, they do not involve a regulatory scheme as pervasive as that enacted by Congress under the Copyright Act of 1978.

Because the preemption by the Copyright Act of 1978 of state law claims for violation of a right of publicity remains unsettled and unaddressed by this Court, commentators and courts have been left to speculate as to how this Court's analysis of preemption prior to 1978 and in patent cases might apply to post-1978 copyright preemption. *See* Shipley, 66 Cornell L. Rev. at 702-11; Apfelbaum, 71 Geo. L. J. at 1588 (urging that under *Goldstein, Zacchini* and *Kewanee* state protection for a right of publicity should be preempted by federal copyright law). This commentator also opined that this Court's companion cases of *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964)

would also support preemption of a right of publicity. Apfelbaum, 71 Geo. L.J. at 1586.

Neither *Sears* nor *Compco* involved copyright questions directly but rather analyzed preemption of state unfair competition laws in a patent context. This Court in *Sears* held that as a result of federal patent laws, "a state may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying." *Sears*, 376 U.S. at 232. A similar result was reached in *Compco*. 376 U.S. at 237. While those cases provide support for the general principle of conflict preemption in the area of intellectual property law, the 1978 amendments to the Copyright Act leave no original work of authorship fixed in a tangible medium of expression uncopyrighted; consequently, the *Sears* and *Compco* decisions provide no direct guidance on the issue raised in this Petition.

(iii) The Fifth Circuit's Analysis

Collectibles does not urge that the Copyright Act preempts all claims of misappropriation of name and likeness or violation of a right of publicity. Nor does Collectibles argue with the general notion that a right of publicity protects an individual's "persona" and that a "persona" is not itself copyrightable. However, when an artist's work has become fixed in a tangible medium of expression, thereby becoming subject to the Copyright Act, and it is the unauthorized reproduction and distribution of the work that is at the core of that artist's allegations, a state law claim for misappropriation of a name and likeness must be preempted lest the Copyright Act's preemption provision be rendered meaningless. By finding that an author's right to protect his "persona" is separate and distinct from the protection afforded his work under the Copyright Act, even when the "persona" appears only in connection with that author's own tangible work,

the Fifth Circuit has expanded the claims that survive preemption to an unprecedented level.

The Fifth Circuit analyzed the question of whether a right of publicity claim is preempted under both the express statutory preemption of 17 U.S.C. § 301(a) and principles of conflict preemption. Preemption will lie when a state claim "actually conflicts with a valid federal statute" or where the claim "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." *Edgar v. MITE Corp.*, 457 U.S. 624, 631 (1982).

The determination of whether a state law claim is expressly preempted by the Copyright Act involves a two step analysis. First, the court must consider whether the cause of the action falls within the general subject matter of copyright. *Daboub v. Gibbons*, 42 F.3d 285, 289 (5th Cir. 1995); 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][2](2000). A cause of action falls within the general subject matter of copyright law if it involves original works of authorship fixed in any tangible medium expression, including musical works and any accompanying words and sound recordings. 17 U.S.C. § 102. Secondly, the Court must consider whether the cause of action asserted protects rights that are equivalent to any of the exclusive rights of the Copyright Act as set out in 17 U.S.C. § 106. *Daboub*, 42 F.3d at 289. Those rights include the exclusive rights to copy and authorize reproduction of the work, prepare and distribute copies, perform the work and display the work. 17 U.S.C. § 106.

There can be no question that musical works, including accompanying words and sound recordings, are within the subject matter of copyright. 17 U.S.C. § 102. The musicians herein brought copyright claims on every one of the musical works at issue in this case on which they claim that their names or

likenesses are found. Secondly, what the musicians sought to recover, and did recover, in the trial court were damages flowing from the reproduction and distribution of musical works fixed in a tangible medium of expression. Thus, the rights that the musicians sought to protect were rights equivalent to those under the Copyright Act. A "right is equivalent to rights under the exclusive province of copyright when it is infringed by the mere act of reproducing, performing, distributing or displaying the work at issue." *Fleet*, 58 Cal. Rptr. 2d at 653; 17 U.S.C. § 106; *see also Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983), *rev'd on other grounds,* 471 U.S. 539 (1985).

The Fifth Circuit has set a dangerous precedent by focusing on the label the musicians chose to give to their cause of action rather than on the core issue involved in their complaint. The basis for the musicians' complaint was the reproduction and distribution of their musical recordings without authorization. In such an instance, the right of publicity does not involve any qualitatively different additional elements and therefore must be preempted. "Because the right of publicity does not require a qualitively different additional element, it is equivalent to a copyright and is preempted to the extent that it is claimed in a tangible work within the subject matter of copyright." *Baltimore Orioles Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 677 n.26 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987). This position also has support from one of the leading commentators. "To the extent that a plaintiff alleges a right of publicity violates a copyrightable work, preemption lies." NIMMER, 1.01(B)(1)(C) (citing *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240-41 (C.D. Cal. 1987).

If Congress intended for there to be reproduction and distribution of original works of authorship without identifying the author or properly crediting the work, then state law claims

for misappropriation of name and likeness in connection with the reproduction or distribution of that work might not be preempted. However, such an intent would be illogical and impractical. Rather, "if under state law the act of reproduction, performance, distribution or display, no matter whether the law includes all such acts or only some, will in *itself* infringe the state created right, then such right is preempted." NIMMER, § 101(B)(1).

(iv) The Fifth Circuit's Analysis of Conflict Preemption

The Fifth Circuit's analysis is not only flawed under the statutory preemption of § 301(a), but it is also flawed under principles of conflict preemption, and compels review by this Court. Conflict preemption has its roots in the Supremacy Clause of the Constitution, U.S. Const. art. VI. If a state law obstructs the accomplishment of the full purposes and objectives of Congress, it is preempted. *Hines v. Davidowitz*, 312 U.S. 52, 66-67 (1941). As the Court below noted, two of the express objectives of the Copyright Act are: "1) to promote national uniformity and avoid the difficulties of determining and enforcing rights under different state laws; and 2) to have copyright protection last for a limited time period so that scholars and the public can benefit from the dissemination of copyrighted materials. . . ." *Brown v. Ames,* 201 F.3d at 660. The fact that there is a clear conflict with regard to the musicians' claims under federal and state protections is evidenced by the fact that federal law and state law in this case yield different results.

Because Collectibles made no profit due to the low sales of the musical recordings at issue, the musicians elected statutory damages under the Copyright Act. Since the jury and the District Court determined that Collectibles' infringement was innocent, the Court awarded $200.00 for the nine musical recordings -- 5 by Nelson, 3 by Mayes, and 2 by Brown -- which the jury found

Collectibles had infringed and for which the musicians had obtained copyright registrations in time to entitle them to statutory damages. However, by virtue of their claims for misappropriation of name and likeness, Respondents Nelson, Mayes and Brown each received additional damages for the exact same sales of their musical recordings. Thus, the Fifth Circuit's opinion fosters the anachronistic, dual system that the Copyright Act was designed to prevent. *See Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166 (D.D.C. 1992), *aff'd*, 15 F.3d 1159 (D.C. 1994) (singer James Brown's "persona" was not severable from his copyrighted performance and thus Brown could not maintain a cause of action for violation of a right of publicity for the use of one of his copyrighted performances in the film "The Commitments.")

Under the Fifth Circuit's reasoning, a plaintiff could recover two sets of damages -- one under federal law for the unauthorized reproduction and distribution of his work, and another under state law for the unauthorized reproduction and distribution of his "persona" in connection with sales of that work. It would be hard to imagine a more direct threat to the uniform system envisioned by Congress than allowing a cause of action to spring up in the state courts of each of the fifty states for a violation of a right of publicity for use of an artist's name of likeness in the distribution of his own tangible work.

Congress could not possibly have intended for the rights to reproduce and distribute a work to be subject to one federal system -- unless the author's name or likeness appears on the work, in which the case the author can bring an action in state court based upon state law instead. Since it is unlikely that any CD or cassette tape is copied or distributed without the name of the artist on it for purposes of identification, and in many cases the likeness of that artist as well, virtually every single copyright claim could be brought as a state law cause of action for

misappropriation. Such a result is particularly ill-considered in this case where the musicians wanted to be publicly associated with these very works, as evidenced by the fact that they claimed a copyright in each of the works for which their names and likenesses were associated.[8]

The dangers to the uniform system envisioned by Congress, and the different results yielded from the federal and state protections in this area, are also evidenced by an analysis of an original work that has entered the public domain. Once a creative work enters the public domain, the work can be freely used without compensation to the original author. *Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1451 (9th Cir. 1991). Indeed, Article I, § 8, cl. 8 of the United States Constitution mandates "free access to copy whatever the federal patent and copyright laws leave in the public domain." *Compco,* 376 U.S. at 237. However, under the musicians' theory of misappropriation, as endorsed by the Fifth Circuit, if a record label places the name of a composer or artist on the product at issue, the artist would be able to bring a claim for misappropriation of name and likeness, or violation of a right of publicity, even though the work is in the public domain. Indeed, that very well may be what happened in this case with regard to Respondents Joe Hughes and Walter Price.

The court submitted a question to the jury as follows: "Do you find the following plaintiffs own valid copyrights in the songs listed below? Answer 'Yes' or 'No' as to each song listed below." In response to the jury issue regarding the sound recordings of Joe Hughes, the jury answered "No." The jury was also asked: "Do you find that the Defendants infringed the

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[8]It is noteworthy that the jury found, by rejecting the musicians' Lanham Act claims, that Collectibles had properly identified the artists and had properly associated the artists with their work.

copyrights owned by Plaintiffs in the songs listed below? Answer 'Yes' or 'No' as to each Defendant." In response to the jury issue regarding the musical work of Walter Price at issue, the jury responded "No." With regard to these questions, the jury was also given the following instruction: "Any work that is in the public domain may be freely copied by any member of the public, including any of the defendants, without liability for copyright infringement." The jury's negative responses to the above questions with regard to Hughes and Nelson may well have been a result of the public domain instruction. Nevertheless, Respondents Hughes and Price were awarded damages for misappropriation for the use of their names in the reproduction and distribution of their songs. This result underscores the danger in creating additional rights related to an original work beyond those of the Copyright Act.

This threat to the system that Congress envisioned is not eliminated by the common law doctrine cited by the Fifth Circuit below, *Brown v. Ames*, 201 F.3d at 660-61, that an "authorized" publisher or distributor can use the name or likeness to identify truthfully the author or creator of the work. *See Zim v. Western Publishing Co.*, 573 F.2d 1318, 1327 (5th Cir. 1978). The Fifth Circuit's reasoning that there is no danger to the express intent of Congress to create a uniform federal system because a claim for misappropriation of name and likeness would only exist where there was "unauthorized" use is inapposite. For one thing, copyright damages are awarded only when there is "unauthorized" use. Thus, allowing additional damages for the same conduct would thwart the uniform system of damages envisioned by the Act.

Moreover, in the case of "unauthorized" copying and distribution, a plaintiff would apparently have a choice as to whether to bring a copyright claim in federal court or a right of

publicity claim in state court. The "dual system" supposedly eradicated by Congress would thereby be resurrected.

Finally, allowing damages for misappropriation of name and likeness or for violation of a right of publicity with regard to musical works, where the musical works reference the name or include in the packaging the likeness of the artist or composer, presents an almost fatal danger to an oldies label such as Collectibles. If a record company such as Collectibles were forced to track down the artist -- or more likely the heirs and/or descendants of an artist -- to obtain the right to use that artist's name or likeness in connection with the sale of that artist's musical work, it would be impractical, if not impossible to do so, and generations of music and other creative works may be lost. This is hardly consistent with the Copyright Act's specific objective that scholars and the public can benefit from the dissemination of copyrighted materials. *Goldstein v. California*, 412 U.S. at 554-56.

Even if it were possible to track down and secure such rights, a record label such as Collectibles would then be subject to the inconsistencies and peculiarities of the rights of privacy and publicity from state to state, and from circuit to circuit, in connection with its reproduction and distribution of vintage musical works. This would clearly conflict with the Copyright Act's objective to promote national uniformity and avoid the difficulties of determining and enforcing rights under different state laws. 17 U.S.C.A. § 301 at 375. "This lack of national uniformity can lead to a curtailment of creative works that portray individuals. The threat of money damages and injunctions may lead many artists, authors, and producers to abandon such works rather than risk the potential legal ramifications." Shipley, 71 Geo. L.J. at 1572.

The Fifth Circuit cited this Court's opinion in *Zacchini* for the proposition that a state law protecting a right of publicity helps to foster creativity in much the same way that copyright laws do.[9] However, such creativity would in no way be stifled by finding that an artist's claims of misappropriation of name and likeness appearing in his own work are preempted by the Copyright Act. An artist who has a copyrightable work will benefit from the public knowing that it is his work. In fact, artists seek the benefit of association with their works by filing for copyright registration, as the artists in this case did.

It has been twenty-two years since the Copyright Act underwent major revision and Congress codified the strong federal interest in promoting the uniform system of rights and remedies for works fixed in a tangible medium of expression. This Court has not addressed the question presented by this Petition, either specifically or broadly, in those twenty-two years.[10] This case presents an opportunity for the Court to interpret and preserve the intent of Congress in enacting the Copyright Act of 1978.

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[9]The Tenth Circuit, however, questioned the economic value of a right of publicity in *Cardtoons,* 95 F.3d at 473-75.

[10]Indeed, one commentator has suggested that the *Zacchini* case would be decided differently after the Copyright Act of 1978 and if Hugo Zacchini had caused his performance to become fixed in a tangible medium of expression (as the musicians in this case did). *See* Shipley, 66 Cornell. L. Rev. at 710-11.

B. A CONFLICT EXISTS AMONG THE FEDERAL CIRCUIT COURTS OF APPEALS REGARDING PREEMPTION OF STATE LAW MISAPPROPRIATION OF NAME AND LIKENESS CLAIMS WHEN AN AUTHOR'S NAME AND/OR LIKENESSES APPEARS IN A COPYRIGHTABLE WORK.

The uniform system of rights and remedies envisioned by Congress compels a more uniform application of preemption of state law claims for misappropriation of name and likeness under the Copyright Act than what has resulted in the absence of any pronouncement from this Court. The Fifth Circuit's opinion, aside from setting a dangerous precedent, conflicts with authority from other circuits. Most notably, the opinion directly conflicts with the Seventh Circuit's decision in *Baltimore Orioles,* 805 F.2d at 674-79. In *Baltimore Orioles*, major league baseball players attempted to assert a cause of action for misappropriation of their names or likenesses in the videotape of a major league baseball game. *Id.* at 666. The Seventh Circuit initially determined that a baseball game is a creative work of authorship that can become copyrightable by virtue of its videotaping, thereby fixing it in a tangible medium of expression.[11] *Id.* at 668. The Seventh Circuit held that once an original work becomes fixed in a tangible medium, the names or likenesses associated with that work are incidental to the work and any cause of action seeking to recover

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[11]The *Baltimore Orioles* decision has been the subject of much criticism, including criticism from the Fifth Circuit in its opinion, for this determination. *See Brown*, 201 F.3d at 659, *Fleet,* 58 Cal. Rptr. 2d at 651. However, in this case, there can be no question that a musical work is an original work of authorship that is copyrightable. Once that point is established, as it certainly is here, the remainder of the Seventh Circuit's opinion in *Baltimore Orioles* squarely conflicts with the holding of the Fifth Circuit.

for the use of those names or likenesses is preempted by the Copyright Act. *Id.* at 674-79.

The Seventh Circuit's decision in *Baltimore Orioles* simply cannot be reconciled with the Fifth Circuit's opinion in this case. Indeed, the analysis of the Seventh Circuit would compel preemption in this case even more. In the *Baltimore Orioles* case, it was the not the major league baseball players who fixed their performances in a tangible medium nor did they themselves claim copyright or attempt to claim copyright in the tangible work. In the case of the Respondent musicians, however, the musicians asserted their rights of publicity in a tangible work within the subject matter of copyright which they themselves created and with regard to which they asserted a copyright claim.

The Fifth Circuit's holding that in this context rights to an author's name and likeness are not equivalent to rights protected under the Copyright Act and therefore the authors' state law claims are not preempted also conflicts with the Eleventh Circuit's decision in *Allison v. Vintage Sports Plaques, Inc.*, 136 F.3d at 1449. In *Allison*, the widow of race car driver Clifford Allison brought claims for violation of her late husband's rights of publicity for the use of his name and likeness on sports trading cards that were subsequently placed on plaques and commemorative clocks sold by the defendant. The Eleventh Circuit held that Allison's right of publicity claim was preempted by the "first sale doctrine" of the Copyright Act, 17 U.S.C. § 109(a). *Allison*, 136 F.3d at 1449. Under the "first sale doctrine" once a holder of intellectual property consents to the sale and distribution of particular copies of the work, as Clifford Allison had with regard to the initial printing of the trading cards, he cannot restrict further distribution of those copies. The Eleventh Circuit therefore held that Allison's complaint regarding the plaques and clocks that contained the trading cards bearing her late husband's name and likeness concerned further distribution

of a work fixed in a tangible medium of expression (the trading cards), and that a right of publicity claim with regard to the name and likeness of her late husband in that tangible work was preempted by the Copyright Act. Thus, unlike the Fifth Circuit, the Eleventh Circuit declined to find that Allison could bring a separate cause of action for use of her husband's "persona" in a tangible work.

The Fifth Circuit relied heavily on two Ninth Circuit opinions in "soundalike" cases, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993) in finding that the misappropriation claims of the musicians were not preempted. Those cases involved defendants had who imitated the vocal style of Bette Midler and Tom Waits in the promotion of automobiles and Doritos, respectively. Because the vocal "style" of a performer is not within the general subject matter of copyright, the Ninth Circuit reasoned that the plaintiffs' claims in those cases should not be preempted.[12] *Waits*, 978 F.2d at 1100; *Midler*, 849 F.2d at 462. However, in this case, the songs at issue were the musical works of the musicians themselves, had become fixed in a tangible medium of expression, and thereby fell squarely within the protection of the Copyright Act. 17 U.S.C. § 106. In choosing to draw an analogy to, and align itself with, the Ninth Circuit "soundalike" cases, the

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[12]The Ninth Circuit opinions holding that liability under state law for use of a "soundalike" in advertising is not preempted by the Copyright Act have also been the subject of scholarly criticism. *See* NIMMER § 1.01 [B][3][b]. In fact, there is considerable discord within the Ninth Circuit itself over the tension between copyright law and the right of publicity. *Id.* at n.286.13. However, Collectibles need not in this Petition address all the issues that arise in "soundalike" reproductions since this Petition does not involve a "soundalike" recording.

Fifth Circuit has created further confusion among the Circuit Courts of Appeals in this area.[13]

In its opinion, the Fifth Circuit also ignored the nature of the damages that the musicians were seeking. The opinion is therefore is at odds with the Tenth Circuit's analysis in *Ehat v. Tanner*, 780 F.2d 876, 878-79 (10th Cir. 1985), *cert. denied*, 479 U.S. 820 (1986). *Ehat* admittedly did not involve a state right of publicity claim but it did involve similar accusations by the plaintiff. In *Ehat,* the core of the plaintiff's complaint was that the defendant had taken and published notes of the plaintiff, a research scholar, without the plaintiff's permission. *Id.* at 877. The plaintiff sued for reputational damages stemming from the taking and publishing of his notes. The Court held that since the injuries stemmed from the taking and distribution of original works fixed in a tangible medium, any damages resulting therefrom would be the exclusive province of the Copyright Act and the plaintiff's claim should therefore be preempted. *Id.* at 878-79.

Similarly, in this case, the musicians sued for damages resulting from the unauthorized sale and distribution of their musical recordings. To support their claim for damages, they presented an expert witness to testify regarding the royalties to which the musicians would be entitled at the statutory rate for a mechanical license based on the sales of musical recordings by Collectibles. Because of the very limited sales of the musical recordings, the musicians elected statutory damages for their copyright claims. Yet the three musicians who recovered statutory

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[13]Even the Ninth Circuit, before *Midler* and *Waits*, recognized that the market value of a musical work does not necessarily create an independent right with regard to the "persona" of the artist that is most closely associated with that work. *See Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

damages from Collectibles for innocent infringement, as well as those musicians whose copyright registrations were not filed in time to qualify for statutory damages, all recovered damages based on sales of the recordings under the guise of their claims for misappropriation of their names and likenesses.

Unlike the Tenth Circuit in *Ehat*, the Fifth Circuit failed to look at the core of the plaintiff's allegations and find that when the alleged damages result from the unauthorized distribution of works fixed in a tangible medium, particularly where they are undisputedly the work of the author (as they were in *Ehat* and as they are here), such damages are preempted by the Copyright Act.

Collectibles submits that the analysis of the Seventh Circuit in *Baltimore Orioles*, in the relevant portion of the opinion, and of the Eleventh and Tenth Circuits in *Allison* and *Ehat*, respectively, represents the better reasoned view and a view that is appropriately sensitive to the intent of Congress.

CONCLUSION

The Fifth Circuit's opinion risks further proliferation of state law claims designed to circumvent the Copyright Act. This case presents an opportunity for the court to address the preemption of such state law claims in the wake of the express intent of Congress in 1978 to establish a uniform system of rights and remedies in the area of copyright. The rights of a recording artist, or any other author of an original work, with regard to the reproduction and distribution of his work are established by the Copyright Act, and should not be subject to variation based on whether or not the author's name or likeness is affixed to the work as reproduced or as distributed. The Circuit Courts of Appeals have treated this important federal issue in inconsistent and confusing ways. For these reasons, this case merits the Court's full consideration.

Respectfuliy submitted,

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U.S. COURT OF APPEALS
FILED
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CHARLES R. FULBRUGE III
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UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 98-20736

LEONARD BROWN; ET AL

Plaintiffs,

LEONARD BROWN; WALTER PRICE; PETE MAYES; JAMES NELSON; CLARENCE PARKER; LEE J. FRAZIER, also known as Skipper Lee Frazier; JOE HUGHES, also known as Joe "Guitar" Hughes; RAYFIELD JACKSON, also known as Houston Guitar Slim; FREDDIE COLLINS, also known as Big Roger Collins; ALFRED R. BETTIS; FALIETA GREEN; THOMAS DARDAR, formerly known as Tommy Dardar, presently known as; DEBRA L. NICKERSON; WELDON BONNER, presently known as Juke Boy Bonner; LIZETTE COBB; ARNETT COBB; KINNEY ABAIR

Plaintiffs-Appellees,

v.

ROY C. AMES, Etc. ; ET AL.

Defendants

ROY C. AMES, doing business as Clarity Music & Some Cooking Records

Defendant-Appellant

COLLECTIBLES INC., doing business as Collectibles Records

Movant-Appellant.

Appeals from the United States District Court for the Southern District of Texas

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Before JONES and DENNIS, Circuit Judges, and PRADO*, District Judge.

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*District judge for the Western District of Texas, sitting by designation.

EDITH H. JONES, Circuit Judge:

Appellants Collectibles and Ames principally appeal the district court's determination that appellees' state law claims for violation of their rights of publicity are not preempted by the Copyright Act. The misappropriation consisted of appellants' unauthorized use of appellees' names and likenesses to market appellees' musical performances on CD's and audio cassettes for which appellants also lacked copyrights. Because a person's name and likeness in themselves are not copyrightable, and because the state law tort for, misappropriation does not conflict with federal copyright law, appellees' claims are not preempted. As the other issues raised on appeal lack merit, the judgment is affirmed.

I. FACTUAL & PROCEDURAL HISTORY

Collectibles is a record label that distributes and sells music recordings, especially repackaged vintage recordings. Ames is a music producer specializing in Texas blues. Appellees are individual blues musicians, songwriters, music producers or heirs of such.

Around 1990, Ames, d/b/a Home Cooking Records, licensed to Collectibles for commercial exploitation master recordings that included performances by appellees. The written license agreements also purported to give Collectibles the right to use the names, photographs, likenesses and biographical material of all those whose performances were on the master recordings. Ames represented and warranted to Collectibles that Ames was entitled to convey these rights. Using the master recordings, Collectibles manufactured and distributed cassettes and CD's, as well as music catalogs, with the names and sometimes the likenesses of the performers on or in them. In addition, Ames, but not Collectibles, sold posters or videotapes with the names or likenesses of the plaintiffs.

In 1994, appellees sued Ames, Collectibles and Jerry and Nina Greene, the owners of Collectibles. Before trial, the district court dismissed appellees' negligence and conversion claims as preempted by the Copyright Act, and dismissed without prejudice the copyright claims of those appellees who had not timely obtained registration certificates. Appellees' actions for copyright infringement, violations of the Lanham Act and for misappropriation of name or likeness under Texas state law proceeded to a jury trial. At the close of appellees' case, the Court granted judgment as matter of law for defendants Jerry and Nina Greene, and the jury found in favor of all defendants on the Lanham Act claims. These rulings have not been appealed.

The jury also found that the defendants had misappropriated the names and likenesses of the appellees and had infringed (in the case of Collectibles, innocently) copyrights held

by some of the appellees. Finally, the jury found that Weldon Bonner had not executed a Recording Agreement with Roy Ames. The jury awarded the appellees misappropriation damages of $127,000--$100,000 from Ames and $27,000 from Collectibles. In its final judgment of August 3, 1998, the court held Collectibles liable for $1,800 for copyright infringement and for $27,000 for misappropriation and Ames liable for $22,500 for copyright infringement and for $100,000 for misappropriation.

Collectibles and Ames have appealed on several grounds. First, they assert that the Copyright Act preempts the misappropriation claims. Second, they assert that the district court should have enforced the allegedly notarized January 1975 Recording Agreement between Ames and Weldon Bonner, notwithstanding the jury verdict that Bonner did not sign it, and that the district court incorrectly instructed the jury on the burden of proof. Third, they claim that the district court improperly awarded a copyright to Leonard Brown for "Ain't Got Much" because his wife wrote the song and he lacked a written assignment from her. Finally, Collectibles, but not Ames, asserts that the plaintiffs did not present legally sufficient evidence to support the misappropriation damages award.

II. DISCUSSION

A. *Preemption*

This Court reviews a district court's conclusions of law de novo. See Pebble Beach Co. v. Tour 18 I Ltd., 155 F.3d 526, 537 (5th Cir. 1998).

The Copyright Act provides that:

> On or after January 1, 1978, all legal and equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in the works

> of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. . .

17 U.S.C. §301(a). Section 301 requires the fulfillment of two conditions. First, the content of the protected right must fall in the subject matter of copyright. Second, the nature of the rights granted under state law must be equivalent to any of the exclusive rights in the general scope of a federal copyright. See Daboub v. Gibbons, 42 F.3d 285, 289 (5th Cir. 1995); see also 1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright §1.01[B] (1999).

In Texas, the tort of misappropriation provides protection from the unauthorized appropriation of one's name, image or likeness. See Moore v. Big Picture Co., 828 F.2d 270, 275 (5th Cir. 1987). It is best understood as a species of the right of publicity or of privacy. See id. To prevail, a plaintiff must prove that (1) the defendant misappropriated the plaintiff's name or likeness for the value associated with it and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) the defendant derived some advantage or benefit. See Matthews v. Wozencraft, 15 F.3d 432, 437 (5th Cir. 1994).

Appellants argue strenuously that appellees have not presented an independent action for misappropriation. Because appellees' names and/or likenesses were used to identify their musical works in Collectibles' CD's, tapes and catalogs, appellants assert that the core of the misappropriation and copyright infringement claims is the same, compelling preemption under section 301 of the misappropriation claims.

Appellants' argument ignores, however, that the content of the right protected by the misappropriation tort does not fall into the subject matter of copyright, as section 301 requires. As the district court correctly recognized, the tort for misappropriation of name or likeness protects "the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or to others." Restatement (Second) of Torts §652C (1977). In other words, the tort of misappropriation of name or likeness protects a person's persona. A persona does not fall within the subject matter of copyright - it does not consist of "a 'writing' of an 'author' within the meaning of the Copyright Clause of the Constitution." Nimmer, supra, §1.01[B] [1] (c]; Jarvis v. A&M Records, 827 F. Supp. 282, 297 (D.N.J. 1993); Bi-Rite Enternrises, Inc. v. Button Master, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); Apigram Publishing Co. v. Factors, Etc., Inc., 1980 WL 2047 (N.D. Ohio July 30, 1980) (available on WESTLAW); Lugosi v. Universal Pictures, 25 Cal.3d 813, 849 (1979) (Bird, C.J., dissenting). Furthermore, contrary to appellants' implications, appellees' names and likenesses do not become copyrightable simply because they are used to identify the source of a copyrighted Work. Therefore, their misappropriation claims do not fit the terms of §301 preemption.

Given the fact that a name or likeness is not copyrightable, appellants' reliance on Daboub is unavailing. In Daboub, the plaintiffs alleged that ZZ Top had both infringed their copyright in and misappropriated one of their songs, and this Court held that section 301 of the Copyright Act preempted the state law misappropriation claim. See Daboub, 42 F.3d at 287, 290. The crucial difference between the two cases is that in Daboub the basis of the misappropriation claim, as well as the copyright infringement claim, was the song itself, bringing it within section 301's ambit, whereas here the basis of the misappropriation claim was defendants' use of plaintiffs' names and/or likenesses.

The appellants also cite Fleet v. CBS, Inc., 58 Cal.Rptr.2d 645 (Cal. Ct. App. 1996), which, although more similar, shares the same factual difference. In Fleet, plaintiffs were actors in a copyrighted film who alleged that the exploitation of the copyrighted work itself infringed their state right of publicity. See id. at 647. They complained not only about the showing of the film, but also about the use of pictures from the film for advertising. See id. Because the individual performances in the film were copyrightable, the court held their claims preempted by federal copyright law. See id. at 650. Thus, Fleet, like Daboub, involved a claim of misappropriation of something -- in Fleet, dramatic performances; in Daboub, songs -- within the subject matter of copyright. This case, in contrast, involves a claim of misappropriation of name and/or likeness, which is not within the subject matter of copyright.

This Court finds the Ninth Circuit's opinions in Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988), and Waits v. FritoLay, Inc., 978 F.2d 1093 (9th Cir. 1992), more persuasive than the case law urged by appellants. These cases, which the district court relied upon, involved the misappropriation of the vocal styles of Bette Midler and Tom Waits. The Ninth Circuit held that because vocal style is not "fixed," it is not copyrightable, consequently, section 301 of the Copyright Act did not preempt a claim of misappropriation of the singer's vocal style. See Waits, 978 F.2d at 1100; Midler, 849 F.2d at 462. In Daboub's language, the content of the protected right (in these cases, the singers' vocal styles) did not fall in the subject matter of copyright. Midler foreshadows the result in this case, reasoning that "[a] voice is as distinctive and personal as a face." 849 F. 2d at 463.[2]

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[2]The legislative history supports this conclusion, stating: "The evolving common law rights of 'privacy,' 'publicity,' and trade secrets ... would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement." H.R. Rep. 1476, 94th Cong., 2d Sess. 132 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5748.

One arguably analogous case has held to the contrary. In Baltimore Orioles v. Major League Baseball Players Ass'n, 805 F.2d 663 (7th Cir. 1986), the Seventh Circuit held that the Copyright Act preempted baseball players' rights of publicity in their performances. The court's conclusion turned on its controversial decision that performances in a baseball game were within the subject matter of copyright because the videotape of the game fixed the players' performances in tangible form. See id. at 674-76.[3] Baltimore Orioles, however, has been heavily criticized for holding that a baseball game is a protectible work of authorship simply because the performance was recorded on videotape that was itself copyrightable. See, e.g., Nimmer, supra, §§1.01[B][1][c] and 2.09[F]; David E. Shipley, Three Strikes and They're Out at the Old Ball Game; Preemption of Performers' Rights of Publicity under the Copyright Act of 1976, 20 Ariz. St. L.J. 369, 384-88 (1988); Shelley Ross Saxer, Baltimore Orioles, Inc. v. Major League Baseball Players Association: The Right of Publicity in Game Performances and Federal Copyright Preemption, 36 U.C.L.A. L. Rev. 861, 870 (1989). In any event, Baltimore Orioles is distinguishable form this case because the right of publicity claimed by the baseball players was essentially a right to prevent rebroadcast of games whose broadcast rights were already owned by the clubs. Viewed in this way, the case is the same as Fleet, Inc. v. CBS, supra. The case before us offers no such complication, as the appellee

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[3]Baltimore Orioles appears to concede that some form of the right of publicity is not preempted by the Copyright Act, e.g., where a company, without the player's consent, used his name to advertise its product or placed the player's photograph on a trading card. 805 F.2d at 676, n.24. The court disagreed, however, with cases on which we have relied, and with their premise that a public figure's persona is not copyrightable because it cannot be fixed in a tangible medium of expression. 805 F.2d at 678 n.26. The court states that, "Becuase a performance is fixed in tangible form when it is recorded, a right of publicity in a performance that has been reduced to tangible form is subject to preemption." Id. If the point of this remark is not inconsistent with the previous footnote, and if we take it as drawing a distinction between the appropriation of a persona and unauthorized copying of one's photograph, we do not disagree. The point isn't relevant to the instant case.

performers did not give permission to the appellants to market their recordings or photographs. We decline appellants' invitation to find name or likeness copyrightable simply because they are placed on CD's and tapes or in catalogs that have copyrightable subject matter recorded on them.

The fact that section 301 does not apply does not end the inquiry, however. Although section 301 preemption is not appropriate, conflict preemption might be. The Supremacy Clause dictates that a state law that obstructs the accomplishment of the full purposes and objectives of Congress is preempted. See Hines v. Davidowitz, 312 U.S. 52, 67, 61 S.Ct. 399, 404, 85 L.Ed. 581 (1941).

The major purpose of the Copyright Act is, as the Constitution states, "to promote the progress of Science and useful arts." U.S. Const., art. 1, § 8, cl. 8. The legislative history of the Copyright Act describes several other objectives: 1) to promote national uniformity and avoid the difficulties of determining and enforcing rights under different state laws; 2) to have copyright protection last for a limited time period, so that scholars and the public can benefit from the dissemination of copyrighted materials; and 3) to improve our international dealings in copyrighted materials. See House Report at 132, reprinted in 1976 U.S.C.C.A.N. at 5745-46; see also Goldstein v. California, 412 U.S. 546, 554-56, 93 S.Ct. 2303, 2308-10, 37 L.Ed.2d 163 (1973).

Although appellants argue vigorously that not preempting appellees' misappropriation claims would undermine the copyright system, several considerations belie this claim. First, the right of publicity that the misappropriation tort protects promotes the major objective of the Copyright Act - to support and

encourage artistic and scientific endeavors.[4] Second, the record here indicates that industry practice may be to transfer rights in a performer's name or likeness when the copyright is transferred.[5] If that is the case, right of publicity claims will rarely interfere with a copyright holder's use of the creator's name or likeness in connection with the copyright. Third, common law on the right of publicity appears ordinarily to permit an authorized publisher or distributor to use name or likeness to identify truthfully the author or creator of the goods.[6] See Zim v. Western Publishing Co., 573 F.2d 1318, 1327 (5th Cir. 1978) (holding that authorization to publish author's work provided implicit authorization to use author's name to identify work); Nevland v. Home Pattern Co., 63 F.2d 363, 364 (2d Cir. 1933) (holding that an implied license to use the name to sell goods arises if the goods have been sold or disposed of) ; Kamakazi Music Corp. v. Robbins Music Corp., 534 F. Supp. 69, 77 (S.D.N.Y. 1982) (holding that the right to use a composer's name or likeness accompanies the grant of the right to use the underlying compositions); Brinkley v. Casablancas, 80 A.D.2d 428, 438 N.Y.S.2d 1004 (S.Ct. 1981) (holding that an unauthorized distribution of a model' s name or likeness was actionable) ; Restatement (Third) of Unfair Competition § 47; 2 J. Thomas McCarthy, The Rights of Publicity or Privacy §7.4 (1999).

Only if states allowed similar claims against authorized publishers or distributors of a work (whether through copyright or the public domain) would the purposes and objectives of the

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[4]The Supreme Court upheld a right of publicity action in Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 97 S. Ct. 2849, 53 L.Ed.2d 965 (1977). There, the Court said: "the protection [afforded by state right of publicity laws] provides an economic incentive for him to make the investment required to produce a performance of interest to the public. The same consideration underlies the patent and copyright laws." Id. at 576.

[5]In fact, Roy Ames purported to transfer these rights as well as the copyright licenses.

[6]Appellants did not make this argument in this litigation.

Copyright Act be adversely affected.[7] Such suits would interfere to some extent with the uniformity of the copyright system and the exploitation of works in the public domain. Currently, however, no state seems to have such a law, and the general rule is as described above. See McCarthy, supra, § 7.4. Thus, because the tort would currently not be sustainable against valid copyright holders, allowing the claim in this context does not impede the transfer of copyrights or the uniformity of the copyright system.

Supreme Court precedent suggesting that courts should steer a middle ground in considering Copyright Act preemption cases supports our conclusion that appellees' misappropriation claims are not preempted. The leading Supreme Court case on preemption in the intellectual property field, Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 109 S. Ct. 971, 103 L.Ed.2d 118 (1989), found that a state statute providing patent-like protection for ideas deemed unprotected under federal patent law was preempted, but warned that "the States remain free to promote originality and creativity in their own domains." Id. at 165. The Court went on to state that: "the case for federal preemption is particularly weak where Congress has indicated its awareness of the operation of state law in a field of federal interest, and has nonetheless decided to "stand by both concepts and to tolerate whatever tension there [is] between them." Id. at 166-67 (citing Silkwood v. Kerr-McGee Corp), 464 U.S. 238, 256, 104 S. Ct. 615, 625, 78 L.Ed.2d 443 (1984)). As noted in the legislative history of section 301, Congress was aware of the operation of state law on the rights of privacy and publicity, and indicated its intention that such state law causes of action remain.[8]

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[7]Appellants did not use the common law described above as a defense to the misappropriation charges. Thus, despite the fact that such a defense would seem to be applicable to some of the misappropriation claims, we cannot decide the case on those grounds or to allow it to influence our preemption analysis.

[8]Furthermore, the several cases prior to Bonito Boats that dealt with preemption in the intellectual property field found that state laws on trade secrets and recording privacy were not preempted by the Copyright Act. See Kewanee

See House Report at 132, reprinted in 1976 U.S.C.C.A.N. at 5748.

Since appellees' misappropriation claims neither fall within the subject matter of copyright nor conflict with the purposes and objectives of the Copyright Act, the claims were not preempted.[9]

B. *Damages*

The jury found that Collectibles owed plaintiffs, in the aggregate, $27,000 for the misappropriation of their names and/or likenesses. Collectibles argues that the plaintiffs did not present legally sufficient evidence on the commercial damage suffered as a result of Collectibles' use of their names and/or likenesses. We disagree. An assessment of damages is not reversed unless it is clearly erroneous, and review and approval of the verdict by the trial judge, such as occurred here, makes appellate review even more deferential. See Ham Marine, Inc. v. Dresser Industries, Inc., 72 F.3d 454, 462 (5th Cir. 1995).

Under Texas law, "[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy." Restatement (Second) Torts, §652C (1977); see also Benavidez v. Anheiser Busch, Inc., 873 F.2d 102, 104 (5th Cir. 1989) (recognizing §652C of the Restatement of Torts as descriptive of Texas law); Kimbrough v. Coca-Cola/USA, 521 S.W.2d 719 (Tex.Civ.App. - Eastland 1975, writ ref'd n.r.e.) (recognizing cause of action for misappropriation under Texas law). ""To prove a cause of action for misappropriation, a plaintiff must show that his or her personal identity has been appropriated by the defendant for some advantage, usually of a commercial nature, to the defendant." Moore v. Big Picture Co., 828 F.2d 270, 275 (5th Cir. 1987)

Oil. Co. v. Bicron Corp., 416 U.S. 470, 94 S.Ct. 1879, 40 L.Ed.2d 315 (1974); Goldstein v. California, 412 U.S. 546, 93 S.Ct. 2303, 37 L.Ed.2d 163 (1973).

[9]As noted above, our conclusion might be different if Texas were to allow such suits against authorized publishers or distributors of a work.

(quoting National Bank of Commerce v. Shaklee Corp., 503 F. Supp. 533, 540 (W.D.Tex.1980)). Furthermore, plaintiffs in misappropriation of name or likeness actions are not required to show that the defendant made money from the commercial use of the name or likeness. See Henley v. Dillard Dep't Stores, 46 F. Supp.2d 587, 597 (N.D.Tex. 1999).

In a misappropriation of name or likeness action, a plaintiff may recover general damages plus any proven special damages. See Shaklee, 503 F. Supp. at 545. "General damages are those which naturally, proximately, and necessarily result from the improper communications." Moore, 828 F.2d at 277. Collectibles argues that the evidence is too speculative to support the damages verdict. While it is true that recovery is not allowed for damages that are speculative or conjectural, "mathematical precision is not required to establish the extent or amount of one's damage." Moore, 828 F.2d at 649. Damages must be "ascertainable by reference to some fairly definite standard, established experience, or direct inference from known facts," but the plaintiff does not have to give an actual dollar value to his injury. Id. In fact one treatise states: "the award of such damages [general damages in an invasion of privacy case] is within the province of the jury and should not be disturbed unless there is a clear showing of excessiveness or impropriety on the part of the jury." J. Hadley Edgar, Jr. & James B. Sales, Texas Torts & Remedies §53.08[l][a] (1999).

In this case, the jury did not clearly err in its damages verdict. The damages awarded fit the Moore criteria: the jury could reasonably have based its estimate of the damages suffered by plaintiffs and even the value of appellees' names and/or likenesses on inferences from the amounts appellees were paid to perform at blues festivals.

C. *The Notarized Contract.*

The jury found that Weldon Bonner did not execute a January 1, 1975 Recording Agreement with Roy Ames. Appellant Collectibles argues that the evidence was insufficient to overcome the presumption of authenticity that attaches to a notarized contract under Texas law.[10] Appellant Ames asserts that the district court erroneously instructed the jury that the burden of proof was preponderance of the evidence when it should have been clear and convincing proof.

A party must object to a jury charge before the jury begins its deliberations in order to preserve its right to appeal that jury charge, unless the error is so fundamental as to be a miscarriage of justice. See Ford v. United Gas Corp., 254 F.2d 817, 818 (5th Cir. 1958); Farrar v. Cain, 756 F.2d 1148, 1150 (5th Cir. 1985). Since Ames did not object to the jury charge on the burden of proof and the alleged error is not so fundamental as to be a miscarriage of justice, he has waived any appeal on that basis.

Collectibles, however, has not waived its appeal as to the sufficiency of the evidence supporting the jury verdict that the notarized contract was invalid. It objected, on the same grounds as it argues here, to the trial court's interrogatory to the jury as to whether Ames and Bonner executed said contract.

Texas law requires "clear and unmistakable proof that either the grantor did not appear before the notary or that the notary practiced some fraud or imposition upon the grantor ... to overcome the validity of a certificate of acknowledgment." Bell v. Sharif-Munir-Davidson Dev. Corp., 738 S.W.2d 326, 330 (Tex. Ct. App. 1987); see also Stout v. Oliviera, 153 S.W.2d 590 (Tex. Civ. App. 1941).

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[10] A jury verdict will be upheld unless, upon reviewing the entire record, the facts and interferences point so strongly and overwhelmingly in favor of one party that the court believes reasonable men could not arrive at a contrary verdict. See Mosley v. Excel Corp., 109 F.3d 1006, 1008-09 (5th Cir. 1997).

Bonner's daughter testified that the signature on the Recording Agreement was not her father's. Several documents in evidence showed Bonner's signature and permitted the jury to draw their own conclusions as to the authenticity of the challenged signature. The jury could reasonably have concluded from the evidence that Bonner did not appear before the notary and his signature was forged, thus overcoming the presumption of authenticity that attaches to a notarized contract. Because this inference was reasonable, we affirm the jury's verdict that the Recording Agreement between Bonner and Ames was invalid.

D. *Leonard Brown's Copyright in "Ain't Got Much"*

Appellants claim that because Leonard Brown's wife wrote the song "Ain't Got Much" and he failed to produce a written copyright assignment from her at trial, the district court erred in granting him a copyright in the song.

Appellants never raised this particular objection to Brown's copyright in "Ain't Got Much" at trial. To avoid being waived, an argument "must be raised to such a degree that the trial court may rule on it." In re Fairchild Aircraft Corp., 6 F.3d 1119, 1128 (5th Cir. 1993); see also Harris County, Tex. v. CarMax Auto Superstores, Inc., 177 F.3d 306 (5th Cir. 1999); FDIC v. Mijalis, Superstores, Inc., 15 F.3d 1314, 1327 (5th Cir. 1994). In its April 2, 1997 motion for judgment, Collectibles (but not Ames) challenged Brown's copyright on the grounds that his misrepresentation to the copyright office of authorship of "Ain't Got Much" invalidated his copyright application for the entire collection it appeared in. Collectibles did not, however, contend that Brown's copyright in the song was invalid because he had not produced a written copyright assignment from his wife. In fact, at no time did Collectibles or Ames raise that particular objection at trial. Consequently, the district court never ruled on it. As a result, appellants have waived the right to appeal on this ground.

III. CONCLUSION

The district court was correct in holding that plaintiffs' misappropriation claims were not preempted, that sufficient evidence supported the damages verdict, and that sufficient evidence supported the jury's determination that the Recording Agreement between Weldon Bonner and Roy Ames was invalid. In addition, appellants waived their right to argue that, because Leonard Brown did not produce a written assignment from his wife, the district court erred in awarding him a copyright in "Ain't Got Much."

AFFIRMED.

Clerk, U.S. District Court
Southern District of Texas
ENTERED
AUG -3 1998

Michael N. Milby
Clerk of Court

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

LEONARD BROWN, ET AL	§	
	§	
Plaintiffs,	§	
	§	
v.	§	CIVIL ACTION NO.
	§	H-94-2637
	§	
ROY C. AMES, *ET AL.*,	§	
	§	
Defendants.	§	

FINAL JUDGMENT

This action came on for trial before the Court and a jury on Plaintiffs' claims of copyright infringement, violations of the Lanham Act, misappropriation of name or likeness, and for declaratory relief. The issues were duly tried, and the jury duly rendered a verdict. Prior to trial, the Court dismissed Plaintiffs negligence and conversion claims as preempted by the Copyright Act, and also dismissed without prejudice the copyright claims of those Plaintiffs who had not yet obtained registration certificates. Furthermore, at the close of the Plaintiffs' case, the Court granted judgment as a matter of law in favor of Defendants Jerry Greene

and Nina Greene. In addition, after trial the Court considered several issues on motions for judgment as a matter of law and granted judgment for the Defendants on the Lanham Act claims. Plaintiffs elected to recover statutory damages rather than actual damages on their copyright infringement claims. Even though statutory damages are a matter for the Court to decide, the Court requested an advisory verdict from the jury on copyright damages. In accordance with the verdict and the Court's rulings, it is ORDERED and ADJUDGED that Plaintiffs recover on their claims as follows:

A. MONETARY AWARDS

Plaintiffs shall take nothing from Jerry Greene and Nina Greene;

Kinney Abair shall take nothing for copyright infringement, and shall recover $1,000 from Roy C. Ames for misappropriation, and $1,000 from Collectibles, Inc. for misappropriation;

Leonard Brown shall recover $17,000 from Roy C. Ames ($5,000 for copyright infringement and $12,000 for misappropriation), and $1,400 from Collectibles, Inc. ($400 for copyright infringement and $1,000 for misappropriation);

Falieta Green, as administratrix of the estate of Clarence Green, shall take nothing for copyright infringement, and shall recover $11,000 from Roy C. Ames for misappropriation, and $3,500 from Collectibles, Inc. for misappropriation;

Joe Hughes shall take nothing for copyright infringement, and shall recover $7,000 from Roy C. Ames for misappropriation, and $2,000 from Collectibles, Inc. for misappropriation;

Pete Mayes shall recover $16,500 from Roy C. Ames ($5,000 for copyright infringement and $11,500 for misappropriation), and $4,400 from Collectibles, Inc. ($400 for copyright infringement and $4,000 for misappropriation);

James Nelson shall recover $20,000 from Roy C. Ames ($12,500 for copyright infringement and $7,500 for misappropriation), and $2,500 from Collectibles, Inc. ($1,000 for copyright infringement and $1,500 for misappropriation);

Robbye R. Waldron, as trustee of the estate of Al Bettis, shall recover $7,500 from Roy C. Ames for misappropriation, and $1,500 from Collectibles, Inc. for misappropriation;

Lizette Cobb shall recover $7,000 from Roy C. Ames for misappropriation, and $1,000 from Collectibles, Inc. for misappropriation;

Roger Collins shall recover $1,000 from Roy C. Ames for misappropriation, and $1,000 from Collectibles, Inc. for misappropriation;

Thomas DarDar shall recover $2,500 from Roy C. Ames for misappropriation, and $1,500 from Collectibles, Inc. for misappropriation;

Rayfield Jackson shall recover $1,000 from Roy C. Ames for misappropriation, and $1,000 from Collectibles, Inc. for misappropriation;

Debra Nickerson, on behalf of the estate of Weldon Bonner, shall recover $21,000 from Roy C. Ames for misappropriation, and $4,000 from Collectibles, Inc. for misappropriation;

Clarence Parker shall recover nothing;

Walter Price shall recover $10,000 from Roy C. Ames for misappropriation, and $4,000 from Collectibles, Inc. for misappropriation;

Lee Frazier shall take nothing.

B. DECLARATIONS

It is further ADJUDGED and DECLARED that:

Weldon Bonner did not execute the purported January 1, 1975 Recording Agreement between himself and Roy C. Ames, and that agreement is therefore void;

Pete Mayes did not execute the purported March 15, 1990 Recording Agreement between himself and Roy C. Ames, and that agreement is therefore void;

Walter Price did not execute the purported August 8, 1988 Bill of Sale between himself and Roy C. Ames, and that agreement is therefore void;

Weldon Bonner executed four Publishing Agreements with Roy C. Ames on January 15, 1975, and those agreements were not procured by fraud;

Weldon Bonner executed a Publishing Agreement with Roy C. Ames on January 21, 1975, and that agreement was not procured by fraud;

Walter Price executed a Recording Agreement with Roy C. Ames on August 10, 1971, and three Publishing Agreements with Ames on July 1, 1971 , and those agreements were not procured by fraud;

James Nelson executed a Recording Agreement with Roy C. Ames on May 1, 1970, and the agreement was not procured by fraud;

Clarence Parker executed a License Agreement with Roy C. Ames on May 1, 1992, and that agreement was not procured by fraud;

Pete Mayes executed a License for Poster Agreement with Roy C. Ames on June 1, 1993, and that agreement was not procured by fraud;

Joe Hughes does not own a valid copyright in the songs *I Can't Figure Out Women* and *The Shoe Shy, Parts 1 and 2*;

Kinney Abair owns a valid copyright in the song *Bow Legged Woman With Green Hair On Her Legs a/k/a Green Haired Woman*;

Leonard Brown owns a valid copyright in the songs *Ain't Got Much* and *Guitar Battle In Mud Alley a/k/a Mud Alley*;

Clarence Green owns a valid copyright in the songs *Trade You Off Blues* and *Blue Billie Blues*;

Floyd D. "Pete" Mayes owns a valid copyright in the songs *Back In School, Christmas Holidays, Crazy Woman, Honeysucker, I'm Ready, Locked Out, Texas Jump, The Word Is Out*, and *LowDown Feeling*;

James Nelson owns a valid copyright in the songs *Crazy Door Bell, Hot Tamale Man, No Knocking Time, No One Woman On My Mind*, and *Working Woman*;

Walter Price owns a valid copyright in the song *What Fool Is That Knocking a/k/a I'm Just a Country Boy*.

C. COSTS AND INTEREST

It is further ORDERED and ADJUDGED that the prevailing Plaintiffs shall recover the taxable costs attributable to the claims on which they prevailed, and postjudgment interest at the annual rate of 5.375 percent. Any award of attorney's fees shall be determined by separate order.

Signed this 29th day of July, 1998.

/S/

JOHN D. RAINEY
UNITED STATES DISTRICT JUDGE

U.S. COURT OF APPEALS
FILED
MAR 23 2000

CHARLES R. FULBRUGE III
CLERK

IN THE UNITED STATES COURT OF APPEALS

FOR THE FIFTH CIRCUIT

No. 98-20736

LEONARD BROWN; ET AL

Plaintiffs

LEONARD BROWN; WALTER PRICE; PETER MAYES; JAMES NELSON; CLARENCE PARKER; LEE J. FRAZIER, also known as Skipper Lee Frazier; JOE HUGHES, also known as Joe "Guitar" Hughes; RAYFIELD JACKSON, also known as Houston Guitar Slim; FREDDIE COLLINS, also known as Big Roger Collins; ALFRED R. BETTIS; FALIETA GREEN; THOMAS DARDAR, formerly known as Tommy Dardar, presently known as; DEBRA L. NICKERSON; WELDON BONNER, presently known as Juke Boy Bonner, also known as Juke Boy Bonner; LIZETTE COBB; ARNETT COBB; KINNEY ABAIR

Plaintiffs - Appellees

v.

ROY C. AMES, Etc.; ET AL

Defendants

ROY C. AMES, doing business as Clarity Music & Home Cooking Records

Defendant - Appellant

COLLECTIBLES INC., doing business as Collectibles Records

Movant - Appellant

- - - - - - - - - - - - - - - - - - -

Appeals from the United States District Court for the Southern District of Texas, Houston

- - - - - - - - - - - - - - - - - - -

ON PETITION FOR REHEARING

Before JONES and DENNIS, Circuit Judges, and PRADO*, District Judge. PER CURIAM:

IT IS ORDERED that the petition for rehearing filed by appellant Collectibles, Inc. in the above case is denied.

ENTERED FOR THE COURT:

/S/ Edith H. Jones
United States Circuit Judge

*District Judge for the Western District of Texas, sitting by designation.

No. 99-2068

Supreme Court, U.S.
FILED
JUL 24 2000
CLERK

In The

Supreme Court of the United States

COLLECTIBLES INC., d/b/a Collectibles Records,

Petitioner,

vs.

LEONARD BROWN; WALTER PRICE; PETE MAYES; JAMES NELSON; JOE HUGHES, a/k/a Joe "Guitar" Hughes; RAYFIELD JACKSON, a/k/a "Houston Guitar Slim"; FREDDIE COLLINS, a/k/a "Big Roger" Collins; FALIETA GREEN as Independent Executrix of the Estate of Clarence Green; THOMAS DARDAR, a/k/a Tommy Dardar; ROBBYE R. WALDRON for the Estate of Alfred R. Bettis a/k/a "Big Al" Bettis; DEBRA L. NICKERSON as heir to the Estate of Weldon Bonner a/k/a "Juke Box Bonner"; LIZETTE COBB as heir to the Estate of Arnett Cobb; and KINNEY ABAIR,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Fifth Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

LAW OFFICES OF DAVID W. SHOWALTER, P.C.
DAVID W. SHOWALTER
Counsel of Record
CHARLOTTE FLOECK
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Attorneys for Respondents

July 24, 2000

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QUESTION PRESENTED

Whether the Fifth Circuit properly refused Petitioner's claim that Petitioner should be allowed to misappropriate musicians' names, images and likenesses when Petitioner was found liable for copyright infringement of words and music of various songs when the copyrighted material did not include names, images and likenesses.

LIST OF PARTIES

1. Kinney Abair, Respondent
2. Al Bettis, Respondent
3. Leonard "Low Down" Brown, Respondent
4. Lizette C. Cobb, Respondent
5. Freddie Collins, p/k/a Big Roger Collins, Respondent
6. Thomas Dardar, Respondent
7. Lee J. Frazier, p/k/a Skipper Lee Frazier, Respondent
8. Falieta Green, on behalf of Clarence Green, Respondent
9. Joe "Guitar" Hughes, Respondent
10. Rayfield Jackson, Respondent
11. Pete Mayes, Respondent
12. James T. Nelson, p/k/a T-99, Respondent
13. Debra Nickerson, on behalf of Weldon Bonner, Respondent
14. Clarence C. Parker, Respondent
15. Walter T. Price "Big Walter", Respondent

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STATEMENT OF THE CASE

Respondents direct the court to the facts as outlined in the opinion of the court of appeals, Pet. App. A1-2 through A1-4, but Respondents add the following.

For the most part, Respondents are Houston area blues musicians, elderly, unsophisticated and uneducated. The trial transcript documents a sordid history of overreaching, misrepresentation and outright misappropriation by Houston area "blues producer" Roy C. Ames. Ames teamed up with Collectibles Record Company to manufacture and sell over $250,000 of stolen recordings. Ames is also a judgment debtor to Respondents. Ames claims to be insolvent and has not appealed the decision of the Fifth Circuit which is adverse to him. Despite extensive dealings with Ames, Petitioner claims to be innocent of Ames' widely known unsavory business practices. Throughout the history of this dispute, Collectibles has taken the position that it is excused from ascertaining whether Ames, its Licensor, actually had the rights he claimed to have to exploit people's recordings or musician's names, images or likenesses because it would be burdensome to a large company that sells so much music. In essence, Collectibles reasons, it is entitled to take advantage of people because it is able to do it on such a broad scale, rather than depriving a few people of their rights one at a time. Collectibles never asked to see Ames' alleged contracts with the Respondents and never made an effort to contact any of the musicians whose musical compositions, names and images Collectibles exploited.

Collectibles is a record label that distributes and sells musical recordings. The words and music of the recordings are the only aspects of Collectibles' product which involved copyrights in this suit. Copyrights of the *words and music* comprised the entire basis of Respondents' copyright claim. Respondents' copyright claims did not involve their *names, reputations or images*. In fact, the Copyright Act does not contemplate extension of the protection of the Act to these separate and distinct rights. Because copyrights in musical recordings protect only the *words and music* of the recording, it is critical to enforce state laws which protect an individual against the unauthorized exploitation of a person's *name, reputation or likeness*. Pet. 3.

Collectibles recognizes that these rights are distinct and arise from separate sources. That is the reason it included *separate* contract provisions in its agreements with Ames that dealt *separately* with the copyrights being licensed and *separately* with the right to use the names, photographs, likenesses and biographical material of the musicians whose compositions were being exploited. Pet. 3.

Like the unauthorized use of a brand name to sell counterfeit products, Collectibles used the Respondents' names, images and reputations without permission to market the counterfeit products. These rights have a recognized value that is *not* the same as a copyright in the words and music of a song. The record demonstrated the value of these rights separate and apart from the value of a song. These rights have a character that stand separately on their own merits. The quantum and calculation of damages is different, there are different standards for

imposing liability, there are different limitations periods, there are different acts which are prohibited, there are different sources of rights, there are different contract provisions relating to them, they are subject to different principles governing transfer and licensing, they are embodied and depicted in different ways, and are communicated and characterized in different ways. The rights are not the same. If Collectibles wants to misappropriate these rights in Texas, California and New York, it must be prepared to be liable under the laws of these states.

Collectibles continues to advance the same tired arguments that failed with the trial court and with the Fifth Circuit. Respondents are the ones most tired of the delay in receiving compensation for the unauthorized use of their names, images and reputations to market musical recordings. Collectibles sold over $250,000 retail value of recordings before they were stopped by Respondents. Respondents have never received a penny from Collectibles. The judgment against Collectibles is only $1,800 for copyright infringement and $27,000 for misappropriation. One has to wonder what Collectibles' real motivation is. Perhaps Collectibles hopes the aging Respondents will die before Collectibles has to pay the judgment.

The trial and appellate courts were not persuaded by Collectibles' arguments. Collectibles has been adjudicated liable for the violation of these musicians' copyrights. Now Collectibles wants a free pass for its unauthorized misappropriation of these musicians' reputations arguing that one wrong exculpates them from a multitude of other wrongs. The Court should decline Collectibles' invitation to become a business partner in this scheme of malfeasance.

REASONS FOR DENYING THE WRIT

The sole question presented by the Petition is whether the Copyright Act preempts a state law claim for misappropriation of name and likeness. Petitioner argues that the Fifth Circuit's opinion improperly holds that the unauthorized appropriation of one's name, image or likeness, as a species of the right of privacy or publicity, is not preempted by the Copyright Act as the rights sought to be protected do not fall into the subject matter granted copyright protection under 17 U.S.C. § 301.

The ruling does not conflict with the Copyright Act. This case has no far-reaching implications. State common law claims for misappropriation of name and likeness and right of publicity are separate and distinct causes of action which can remain intact without threatening the uniform systems of rights and remedies the Copyright Act was designed to provide. The Fifth Circuit's ruling was proper in all respects and Respondents respectfully urge this Honorable Court to deny the Petition for Writ of Certiorari.

A. THE FIFTH CIRCUIT'S DECISION IS SIGNIFICANT IN THAT IT REQUIRES A WRONGDOER TO PAY A MODEST AMOUNT OF DAMAGES. OTHERWISE, THE DECISION HAS NO SIGNIFICANCE IN FEDERAL JURISPRUDENCE.

Collectibles ludicrously argues that the Fifth Circuit decision conflicts with the preemptive intent of the Copyright Act, creating a legal twilight zone when a plaintiff brings a cause of action for misappropriation. Petitioner

reasons that doing one type of damage to Respondents excuses Petitioner's other illegal conduct.

This is not the first case Collectibles and its accomplice Ames have lost on the preemption v. misappropriation issue. In *King v. Ames*, 179 F.3d 370 (5th Cir. 1999), these same parties were held liable to the heirs of late great blues musician Freddy King. In that case the Plaintiff was intimidated into dismissing her appeal against Collectibles because she could not pay court costs arising from another aspect of the judgment and consequently Collectibles escaped the liability for misappropriation which was later upheld by the Fifth Circuit.

The protection provided by the Copyright Act is totally different than the protection offered by the state laws prohibiting misappropriation. Misappropriation is an elemental concept of equity. You do not take what does not belong to you. Conversely, the Copyright Act creates a statutory scheme that limits exploitation of certain intangible ideas that have been fixed in tangible form in certain instances of use.

Misappropriation has been characterized as a species of the right of publicity or of privacy. *Moore v. Big Picture Co.*, 828 F.2d 270, 275 (5th Cir. 1987). The right of publicity is the right of a person whose identity has commercial value – most often a celebrity – to control the commercial use of that identity. *Waits v. Frito-Lay*, 978 F.2d 460, 1098 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993).

[T]he legislative history of section 114 indicates the express intent of Congress that "[t]he evolving common law rights of privacy, publicity, and trade secrets . . . remain unaffected [by the preemption provision] as long

as the causes of action contain elements, such as an invasion of personal rights . . . that are different in kind from copyright infringement." H.R. Rep. No 1476, 94th Cong., 2d Sess. 1321, reprinted in 1976 U.S.C.C.A.N. 5659, 5748.

A misappropriation claim does not create "vague borderline areas" between state and federal law as Petitioner asserts when Congress has expressly noted which types of claims will not be preempted.

B. NO CONFLICT EXISTS AMONG THE FEDERAL CIRCUIT COURTS OF APPEALS BECAUSE MISAPPROPRIATION IS A DISTINCT AND SEPARATE CAUSE OF ACTION OUTSIDE OF THE SUBJECT MATTER CONTEMPLATED BY SECTION 106 OF THE COPYRIGHT ACT.

Collectibles misstates the facts of this case and misstates the authority it cites in its effort to argue that misappropriation claims are preempted or subsumed by the Copyright Act. Petitioner blatantly attempts to mislead the Court into believing that the Respondents' names and/or likenesses appear in the copyrighted works. Pet. p. 23.

Nothing could be further from the truth. None of the Respondents' names or likenesses are included in the copyrighted works. Respondents' copyrights only covered the words and music. Reliance on the *Baltimore Orioles Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987), is completely misplaced. In *Baltimore Orioles*, the copyrighted material was the images and visual performances

of the baseball players. Does Collectibles believe that if the *Baltimore Orioles* case involved a copyrighted soundtrack of bats hitting balls and players sliding into base where none of the players' names or pictures were part of the soundtrack that Collectibles would be free to misappropriate the players' images and names for the purpose of marketing its soundtrack? Not hardly.

Likewise, *Allison v. Vintage Sports Plaques,* 136 F.3d 1443 (11th Cir. 1998) is completely inapposite. In *Allison,* the copyrighted property was the likeness of the person involved. Collectibles' argument that these cases are instructive and evidence a conflict among the circuits demonstrates the invalidity of Collectibles' arguments.

Copyright protection extends to "original works of authorship fixed in any tangible medium of expression" 17 U.S.C. § 102(a).

Section 102 clearly sets forth the subject matter of copyright.

> (A) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or a device. Works of authorship include the following categories:
>
> (1) literary works;
>
> (2) musical works, including any accompanying words;
>
> (3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

17 U.S.C.A. § 102(a).

Section 102 is silent on the protection of the 'persona' of the author or creator of the works. A person's name and likeness are not mentioned and are not given protection under the Act. The Act makes no further provision expressly granting protection once the name or likeness is incorporated into the work.

In *Midler v. Ford Motor Co.*, 849 F.2d 460, 461 (9th Cir. 1988) the Court discussed the distinction between the protection of a work of authorship and something more personal. *Midler* involved an artist's claim of misappropriation of her vocal style. The court upheld her claim because it was a personal right not within the realm of the Copyright Act. The Court reasoned that a voice is "one of the most palpable ways identity is manifested". *Id.* at 463.

Likewise, Respondents are seeking the protection of a form of identity, even more personal than a voice. One's name and likeness are more closely associated with a human identity than is a voice.

Petitioners fail to meet the two-part preemption analysis set forth in *Daboub v. Gibbons*, 42 F.3d 285, 289 (5th

Cir. 1995) which requires that the cause of action fall within the general subject matter of the copyright law and whether it protects rights that are equivalent to any of the exclusive rights of the Copyright Act in 17 U.S.C. Section 106 which provide the owner of a copyright with "the exclusive rights to do and authorize any of the following:"

> (1) to reproduce the copyrighted work in copies or phonorecords;
>
> (2) to prepare derivative works based upon the copyrighted work;
>
> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
>
> (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
>
> (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
>
> (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C.A. § 106.

The statute grants the rights to reproduce, prepare derivative works, distribute, perform, display. Noticeably

absent from the list is any mention or contemplation of the rights to one's own persona. Collectibles does not even argue that the names, images and likenesses are included in the copyrighted materials for which copyright protection was claimed or granted.

Petitioners improperly argue that the availability of this separate cause of action under state law would undermine the intent of Congress in its attempt to eradicate the "dual system". Pet. p. 20. Yet, Petitioners take the contradictory stance that they do not assert that the Copyright Act preempts all claims of misappropriation yet they state that once it becomes fixed in a tangible medium of expression it becomes part of the subject matter of the Copyright Act. Pet. p. 14.

Petitioners would have this Court believe that upon the procurement of a copyright, one relinquishes personal rights to privacy or publicity. If this is so, the intent of Congress would be thwarted. This policy would discourage more seekers of a copyright than promote the dissemination of material.

CONCLUSION

The Fifth Circuit's decision does nothing more than pretermit the pickpocket mentality of Collectibles' petition. Collectibles infringed copyrights, now it wants to be excused for its damage to the Respondents' right of publicity and privacy. The misappropriated images and names were not part of the copyrighted material. If Collectibles wanted to use these valuable rights it should have obtained permission and paid for them. This case

raises no significant issues of copyright law that warrant this Court's review.

For all of the foregoing reasons, Respondents respectfully request that this Honorable Court deny the petition.

Respectfully submitted,

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Supreme Court, U.S.
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No. 99-2068

IN THE

Supreme Court of the United States

COLLECTIBLES, INC., d/b/a Collectables Records

Petitioner,

vs.

LEONARD BROWN; WALTER PRICE; PETE MAYES; JAMES NELSON; JOE HUGHES, a/k/a Joe "Guitar" Hughes; RAYFIELD JACKSON, a/k/a "Houston Guitar Slim"; FREDDIE COLLINS, a/k/a "Big Roger" Collins; FALIETA GREEN as Independent Executrix of the Estate of Clarence Green; THOMAS DARDAR, a/k/a Tommy Dardar; ROBBYE R. WALDRON for the Estate of Alfred R. Bettis a/k/a "Big Al" Bettis; DEBRA L. NICKERSON as heir to the Estate of Weldon Bonner a/k/a "Juke Boy Bonner"; LIZETTE COBB as heir to the Estate of Arnett Cobb; and KINNEY ABAIR

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

PETITIONER'S REPLY MEMORANDUM

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THE MUSICIANS' BRIEF IN OPPOSITION FURTHER SUPPORTS THE GRANTING OF COLLECTIBLES' PETITION

Respondents' Brief in Opposition to the Petition for Writ of Certiorari of Collectibles, Inc. is long on vitriol and short on reasons for denying the writ. Indeed, the respondent musicians' Brief highlights the dangers to the uniform federal system of rights and remedies promulgated by the Copyright Act, as well as the confusion that exists in the absence of any pronouncement by this Court on the scope of preemption after the 1978 enactment of Section 301(a) of the Copyright Act.

A. The musicians misconstrue the right of publicity tort.

Initially, the musicians misapprehend the rights protected by the state common law tort of misappropriation of name and likeness. As even the Fifth Circuit has noted, "[t]he misappropriation tort does not protect one's name *per se* . . ." but rather the commercial value associated with one's name or likeness. *Matthews v. Wozencraft*, 15 F.3d 432, 437 (5th Cir. 1994); *see also Rogers v. Grimaldi*, 875 F.3d 994, 1003 (2d Cir.

1989). In fixing a work in a tangible medium of expression, and claiming copyright protection for that work, an author or creator seeks to be associated with that work and to benefit commercially from such association with that work. *See, e.g., Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors. . . .").[1]

The association of a performer's name or "persona" with his own copyrightable performance enhances rather than diminishes the commercial value of his name and his "persona." To allow such a benefit to inure to an author under the Copyright Act, while still imposing additional liability for misappropriation

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[1]In fact, Collectibles, pursuant to its licensing agreements with producer Roy C. Ames, paid all royalties due and owing on the sales of the CD's and cassettes at issue to Ames. The evidence at trial showed that Ames in turn paid or credited royalties to the musicians. *See Allison v. Vintage Sport Plaques*, 136 F.3d 1443, 1449 (11th Cir. 1998) (noting that despite the preemptive effect of the first sale doctrine of the Copyright Act on the right of publicity, the celebrities at issue still received royalties from the first sale of the property at issue).

under the particular common laws of the fifty states for associating the "persona" of the author with his own work, is inconsistent with the fundamental philosophy of the Copyright Act and further defeats the express preemptive intent of the Act.[2]

B. The musicians recognize the consequences of the Fifth Circuit's holding below.

The musicians assert that the Fifth Circuit opinion does not have "far reaching implications." *See* Respondents' Brief at p. 4. However, immediately before this assertion, the musicians acknowledge that any publisher, such as Collectibles, that uses the names and likenesses of the author of a tangible work in connection with the sale of that tangible work should be liable under the laws of "Texas, California and New York," not to

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[2]The proposition that an author of a work fixed in a tangible medium of expression, especially one who attempts to register for copyright protection, wants not only his name but also his "persona" associated with that work is underscored here. Contrary to the musicians ill-considered attempt to rephrase the question presented, every copyright claimed by the musicians included the name of the musician, and the claimed copyrights in sound recordings would necessarily include the "likeness" (i.e. the voice) of the musician. Moreover, many of the deposit copies for which the musicians claimed copyright consisted of the actual Collectibles CD's, which not only bore the complained of names and likenesses (i.e. voices) of the musicians but sometimes their images as well.

mention the other fifty states (*See* Respondent's Brief at p. 3). Thus, the musicians acknowledge the threat to the uniform federal system Congress envisioned for works fixed in a tangible medium of expression.

The musicians cite the legislative history of § 114 of the Copyright Act for the proposition that certain species of the "evolving common law rights of privacy, publicity and trade secrets" remain unaffected by the preemption provision of the Act. H.R. Rep. No. 1476. 94th Cong. 2d Sess. 201 (1976) *reprinted following* 17 U.S.C.A. § 301 at 377. The musicians apparently claim that the right of publicity has developed to such an extent that it allows authors of works fixed in a tangible medium of expression to assert causes of action based on the misappropriation laws of the fifty states, rather than the Copyright Act, for the unauthorized use of their own fixed, tangible works as long as those works include their names or likenesses. This argument only supports the granting of

Collectibles' Petition in order to consider whether such common law rights have evolved, or can evolve, to such a degree.

C. <u>There exists an irreconcilable conflict between the circuits.</u>

The musicians in their Brief attempt to minimize the patent conflict between the Fifth Circuit, on the one hand, and the Seventh and Eleventh Circuits, on the other, by contending that *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987) and *Allison v. Vintage Sports Players* stand for the proposition that a right of publicity claim may be preempted only when the likeness of the individual asserting such a claim appears in the copyrighted work. This attempted distinction is unsupported. Indeed, *Baltimore Orioles* is much broader than as characterized by the musicians and specifically addresses the preemption issue when a "performance," like the musicians' performances in this case, is fixed in a tangible form. "Because a performance is fixed in tangible form when it is recorded, a right of publicity in a

performance that has been reduced to tangible form is subject to preemption." 805 F.2d at 678 n.26.

To further illustrate the direct conflict between the circuits, the Fifth Circuit in its opinion below cited this Court's holding in *Zachini v Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). Yet the Seventh Circuit expressly stated in *Baltimore Orioles* that had *Zachini* been decided after § 301(a) of the Copyright Act became effective in 1978, and had Hugo Zachini caused his human cannonball act to be recorded (i.e. fixed in a tangible medium of expression) -- two factors that are present in the instant case[3] -- the *Zachini* case would have been decided differently. 805 F.2d at 675 n.22.

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[3]Oddly, the musicians at one point, in their zeal to use pejorative terms, label the recordings "counterfeit" (Respondent's Brief at p. 2), though at another point in their Brief they inconsistently refer to the recordings as "stolen." (Respondent's Brief at p. 1). The fact remains, however, that the musicians themselves claimed a copyright on each and every one of the musical works at issue and there was no finding by the jury, nor was there even a request for one, that the recordings were "counterfeit." Moreover, there was no question that the musicians themselves were responsible for, and participated in, their performances becoming "fixed."

D. **The musicians' erroneous factual assertions**

Finally, the musicians' factual assertions in their Brief are, for the most part, as irrelevant as they are erroneous and unsupported by the record. Thus, Collectibles need not address each and every such statement. However, the musicians citation of, and discussion of, *King v. Ames*, 179 F.3d 370 (5th Cir. 1999) is particularly fallacious. As may be inferred from the musicians' barbed discussion of that case, Collectibles was awarded a take nothing judgment in the trial court and was awarded its costs. As the Fifth Circuit opinion makes clear, King did not pursue an appeal against Collectibles. 179 F.3d at 372 n.2. Most importantly, the *King v. Ames* opinion does not address, discuss or in any way decide the preemption issue presented herein. The assertion that Collectibles "lost" anything in that case, or that the case is somehow relevant to the Court's consideration of Collectibles' Petition herein, is entirely unfounded.

CONCLUSION

The musicians' contentions regarding Collectibles' susceptibility to state law misappropriation claims in the fifty states for reproduction of sound recordings bearing the name and likeness of the recording artist or composer, and the musicians' contentions regarding how far such misappropriation claims have "evolved" since 1978, only highlight the reasons why this case merits the Court's full consideration.

Respectfully submitted,

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